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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,132	06/15/2001	Peter Richard Reeves	6433/80968	7192
24628	7590	01/19/2006	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			MYERS, CARLA J	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/701,132	Applicant(s) REEVES ET AL.	
	Examiner Carla Myers	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

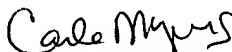
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 32,34,35,37,38,40-42,46-49,56-61,63 and 66-69.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


 CARLA J. MYERS
 PRIMARY EXAMINER

Continuation of 3. NOTE: the amendment to claims 32 and 34 to recite a nucleic acid comprising any 10 to 20 nucleotides of SEQ ID NO: 13 raises new issues under 35 USC 112 first paragraph and under 35 USC 102/103. While the claims previously included nucleic acids comprising nucleotides 586 to 606 or nucleotides 791 to 810 of SEQ ID NO: 13, the claims did not previously include nucleic acids that comprise any 10 to 20 nucleotides of SEQ ID NO: 13 flanked on the 3' and/or 5' end by nucleotides of any number and identity. The amendment to claim 67 also raises new issues under 35 USC 112 second paragraph. The proposed claim recites "a nucleic acid molecule according to claim 32 the nucleotide sequence of SEQ ID NO: 57." However, it is unclear as to what is intended to be the relationship between the nucleic acid molecule of claim 32 and the sequence of SEQ ID NO: 57.

Continuation of 11. does NOT place the application in condition for allowance for the reasons of record in view of the non-entry of the after final amendment. Further, Applicant's response argues that the 112 first paragraph rejection has been overcome by the proposed amendment to recite that the primers have a length of 10 to 20 bases. However, the proposed amendment includes primers that comprise 10 to 20 bases of SEQ ID NO: 13 and therefore the primers are not in fact limited to a length of 10 to 20 nucleotides - i.e., in view of the comprising language the primers contain any 10 to 20 nucleotides of SEQ ID NO: 13 flanked by additional nucleotides of any length and identity. Currently pending claims 37 and 38 also include primers that comprise 10 to 20 nucleotides and thereby these primers are not limited to a length of 10 to 20 nucleotides. The response states that the basis for the rejection under 35 USC 112, second paragraph is not understood as the rejection applies to claim 61. To clarify, claim 61 depends from claim 58 or 59. Claims 58 and 59 recite "(a) a nucleic acid molecule according to claim 32." Claim 32 is limited to a single isolated and purified nucleic acid comprising SEQ ID NO: 13. Yet claim 61 recites "wherein the nucleic acid molecule of step (a) comprises a forward and a reverse primer" - i.e., a forward primer in the 5' to 3' orientation and a reverse primer which is the inverse complement of the stated sequence. It is unclear as to how a single nucleic acid molecule can comprise both the recited forward and a reverse primers. Lastly Applicants state that Mirzabekov does not teach all possible 8-mers and that Applicants were not able to find the passage cited in the Office action referencing paragraph 99 of Mirzabekov. Further, Applicants cite a passage from the Mirzabekov patent which indicates that chips containing specific oligomers can be used to fingerprint mutations. Applicants arguments have been fully considered but are not persuasive. Mirzabekov does in fact teach a chip containing all possible octamers. At paragraph 99, the patent states "The 75-base fragment 810 is subjected to a hybridization chip (not shown) containing all possible octamers. As a result of the hybridization step, a list, 816 of all heptamers (7-mers), with portions of immediately adjacent oligos, in the original 75-base fragment is generated." Accordingly, while Mirzabekov does teach chips containing only specific oligos, Mirzabekov also teaches chips which contain all possible octamers. Further, it is noted that the proposed amendment to claims 37 and 38 would not overcome the present rejection. While the proposed amendment recites that the primer comprises an isolated and purified nucleic acid of about 10 to 20 nucleotides, the primer itself is not isolated and purified. Thereby, the primer of claim 37 and the composition of claim 38 may include additional primers, such as the full set of octamers disclosed by Mirzabekov.